



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/068,570
Applicant(s): Vodyanoy *et al.*
Filed: 02/06/2002
Art Unit: 1641
Examiner: C.J. Cheu
Title: LIGAND SENSOR DEVICES AND USES THEREOF

Confirmation No.: 6923

Docket No.: 35721/243744 (5721-18)
Customer No.: 00826

January 6, 2004

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT
37 CFR § 1.115

Sir:

Please enter this Preliminary Amendment before calculating the claim fee and amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims beginning on page 4 of this paper.

Remarks begin on page 8 of this paper.

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RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated December 12, 2003, in which the Examiner has required restriction between Group I, namely Claims 1 and 6-19, Group II, namely Claims 2-5, and Group III, namely Claims 20-22. Applicants hereby provisionally elect with traverse to prosecute the claims of Group II (Claims 2-5) and expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims. Applicants note that a preliminary amendment is also being filed in the case to make changes to the claims in view of the restriction.

With regard to the restriction requirement, Applicants respectfully note that Groups I and II are related, and request that the Examiner reconsider and examine these groups together. Group I is directed to a method for evaluating the affinity of one or more ligands for a peptide. The claims of Group II are dependent on or incorporate the limitations of claim 1; thus, the claims of Group II are also directed to a method for evaluating the affinity of one or more ligands for a peptide. 37 CFR §1.142 requires that restricted inventions be "independent and distinct." According to MPEP 802.01, "independent" requires that there is not a disclosed relationship between the two or more subjects disclosed. The relationship of Groups I and II does not meet this standard, and therefore it is respectfully requested that these groups be rejoined and examined together.

Further, Applicants note that the claims of Group II contain additional limitations regarding a particular step of the method claimed in the Group I claims. Specifically, the claims of Group II contain additional limitations regarding step (c) of claim 1, *i.e.*, "preparing said sensor to be coupled to said peptide." Accordingly, a search encompassing the subject matter of Group II will also

encompass the subject matter of Group I; therefore, no additional burden will be placed on the Examiner if the claims of Group I and Group II are considered together.

For the above reasons, Applicants respectfully request that Groups I and II be rejoined and considered together. Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Leigh W. Thorne
Registration No. 47,992

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

"Express Mail" mailing label number EV 390050496 US
Date of Deposit January 6, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Lynda-Jo Pixley

